

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Ernest Voisin

Serial No.: 09/ 121,725

Filed: July 24, 1999

For: A Process of Elimination of Bacteria
In Shellfish, of Shucking Shellfish and
An Apparatus Therefor

To the Honorable Commissioner
Of Patents and Trademarks
Washington, D.C. 20231

Box: Board of Patents Appeals and Interferences

Group Art Unit: 1761

Examiner: Drew Becker

Date: July 9, 2001

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BOARD OF PATENT APPEALS
AND INTERFERENCES

REPLY BRIEF

Sir:

This is a Reply Brief with respect to Examiner's Answer mailed on May 9, 2001.

Examiner re-iterates his position that Claims 6 and 7 are anticipated by JP 4356156, alleging that even though the cited reference fails to disclose any effect of the treatment method on naturally-occurring marine bacteria, one of ordinary skill in the art would have expected the same result as inherent in the method of the cited reference. Examiner alleges that the result achieved by the method of the present invention is not unique "absent clear and convincing evidence or arguments to the contrary."

Examiner ignores a detailed statement of Dr. Marilyn Kilgen, Head of the Department of Biological Sciences at Nicholls State University who was researching the problem of Vibrio contamination and solutions to that problem. She describes in detail various techniques that she is aware of that have been used and proved unsuccessful. Dr. Kilgen, at the request of the applicant, tested the novel method of the instant invention and was satisfied that the method disclosed by the applicant worked.

The appellant further submitted a statement from Robert L. Collette, VP of Science and Technology of National Fisheries Institute who was impressed by the solution offered by the present invention "considering the amount of time and money spent by universities and scientists worldwide to solve this problem" [*Vibrio Vulnificus* bacteria].

The appellant further submitted a statement from Dr. Michael W. Moody, Seafood Technologist of the Louisiana State University Agricultural Center. After introducing his impressive credentials, Dr. Moody described the problem of raw molluscan shellfish contamination by *Vibrio Vulnificus*. Dr. Moody stated that "prior to Mr. Ernest Voisin contacting him about the possibility of using high pressure treatment for the elimination of *Vibrio Vulnificus* in raw molluscan shellfish, [he] was not aware of the process being used anywhere or by anyone for that purpose." Dr. Moody continued to state that he "was not aware of anyone suggesting that the process be used for that purpose." This is additional evidence that a "person of ordinary skill in the art" considers the instant invention novel and nonobvious.

However, despite this clear and convincing evidence submitted by scientists who have more than ordinary skill in the art, Examiner continues to doubt novelty of the instant invention. According to the Examiner, a reference that speaks of opening shellfish inherently discloses solution to the problem of *Vibrio* contamination.

Examiner indirectly acknowledges that the teachings of JP 4356156 are not sufficient to anticipate Claims 6 and 7. However, to bootstrap his position, Examiner brings another reference, Cheftel's review (incidentally, also supplied by the applicant in one of his Information Disclosure Statements) on high-pressure processing studies conducted around the world. Cheftel describes in detail findings of others on the effects of high pressure (1-7 kbar) on food constituents, such as water, proteins and lipids, on destruction of microorganisms through pressure or combined pressure/temperature/food additive processing. (p. 195) The article

describes the effect of high-pressure processing on juices, jams, meat (showing change in color at pressure in excess of 3 kbar), milk, egg whites, etc. Conspicuously absent from this extensive review of studies is any reference to studies or tests for the application of high-pressure processing on naturally occurring marine bacteria, such as *Vibrio Vulnificus*.

Cheftel's article mentions in one line a *potential* (not *known*, as Examiner would have us believe) application of pressure processing on *Vibrio* and viruses in seafoods (p. 204). However, the listing of potential applications, which includes juice preservation, enzyme inactivation, meat tenderizing, sterilization, pasteurization, etc. has numerous caveats conveniently overlooked by Examiner - these applications have to wait until higher-capacity equipment is developed, until temperature control is defined, until better sanitation is achieved, until lower cost constituents can be developed, etc.

This uncertainty and a long list of pre-requisites are ignored by the Examiner who prefers to see Cheftel's article as proof that the use of pressure processing at 1-7kbar is evidence of obviousness to a person of ordinary skill in the art of "inherency" of the instant invention from JP 4356156. Such position cannot be sustained either on the basis of the references, or in view of the material evidence of record submitted by the appellant.

In effect, Examiner creates a rejection based on a combination of references, where elements essential to the claims under examination lack one or more important feature and another reference has to be brought in to establish obviousness. However, rejections under Section 102, by law, have to be based on a single reference. Material elements recited in the claim must be found in one unit of prior art to constitute anticipation. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986);

W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) (anticipation cannot be based on conjecture).

Examiner states that Cheftel "does not add to the teachings of JP 4356156 but rather merely provides evidence of the teaching of the JP 4356156 patent." First, JP 4356156, based on the evidence of record, is not a patent, it is a published application. Attention of the Board is respectfully drawn to the file history of that application (obtained and translated by the appellant). Second, the article, due to its reference to "potential" applications, does not provide the necessary evidence of the "missing descriptive matter." To make such a conclusion, one would have to believe that the Wright brothers did not invent the airplane because de Vinci inherently disclosed a flying apparatus.

In view of the above, the appellant respectfully requests that rejection of Claims 6 and 7 under 35 USC 102 be re-considered and withdrawn.

Examiner further continues rejection of Claims 3 and 4 under 35 USC 103. Here, Examiner simply states that "the method steps utilized in the reference are the same as those instantly claimed, and thus the same result would also have been expected." Examiner does not bother to address the evidentiary material, statements of persons intimately familiar with the field of the invention, the evidence that is even more important in cases of Section 103 rejection.

Examiner responds to appellant's arguments on the results of the International Search Report in a corresponding International Application by stating that "the European Patent Office is not the same entity as the USPTO and does not operate under the same rules and laws." Examiner then goes on to speculate that the reasons why the ISA examining officer classified JP 4356156 as a category "A" reference is because the abstract incorrectly listed the pressure range and that "the true pressure range was not apparent until the Examiner had the reference fully translated." This statement is not based on any fact or evidence of record. Is it not equally

possible that the European patent examiner was conversant in Japanese and required no translator? Is it not equally possible that the ISA examiner properly evaluated the teachings of JP 4356156?

More importantly, the appellant respectfully submits that the same references were available to US Examiner in one of the divisional applications based on S.N. 09/121,725. The claims of that divisional application were directed to a process of shucking oysters, reciting the same or similar pressure and time criteria as the claims on appeal. The claims of that application were allowed and issued as US patent No. 6,217,435. Examiner in that application was governed by the same patent laws and rules as the Examiner in the instant case. Such diametrically opposite results coming from the same Patent Office, albeit from different examiners, defy any logical explanation. It is cases like this that lead to unpredictability of US examination, the cause that raises great concern both domestically and abroad.

Examiner then briefly states that the three declarations "obtained" by the appellant do not mention or discuss JP 4356156. As submitted above, the scientists who presented their opinions on the novelty and nonobviousness of the present invention addressed the problem of Vibrio contamination. Since JP 4356156 has not one word directed to this problem or to its solution, the mention of that reference would not have changed the fact that all of the scientists were either "surprised" or "impressed" by the appellant's achievement in this field.

Examiner uses paragraph 2112 of MPEP in an effort to prove that when using the inherency doctrine, he is not obligated to establish prima facie case of anticipation or obviousness, conveniently ignoring the words "not necessarily make the claim patentable." The converse is equally true - unknown function does not necessarily make the claim *unpatentable*.

When addressing appellant's arguments with regard to Section 103 rejection and the use of hindsight reconstruction, Examiner states that Cheftel supplies that necessary element,

knowledge of ordinary skill in the art to the inherent disclosure of JP 4356156. As stated above, Cheftel writes about "potential" applications, not yet supported by the technology and contingent on several vital pre-requisites. To make a sweeping statement that that one line from Cheftel's article bridges the gap and provides the missing element is impermissibly stretching the teachings of both JP 4356156 and Cheftel.

In view of the above, the appellant respectfully requests that rejection under 35 USC 103 be re-considered and withdrawn.

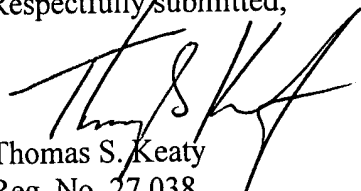
Allowance of Claims 3, 4, 6 and 7, all claims on appeal, is respectfully requested.

The appellant requests an oral hearing pursuant to 37 CFR 1.194. A separate request and a fee of \$135 accompany this Reply Brief. Please charge any deficiency and credit any overpayment to Deposit Account No. 11-0260 of the undersigned.

The appellant further requests that this application be made "special" pursuant to 37 CFR 1.102(c) - appellant's age. A Petition under 37 CFR 1.102 accompanies this Reply Brief.

<u>CERTIFICATE OF EXPRESS MAILING</u>	
I certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. ET283476379US in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, Box: Board of Patents Appeals and Interferences, on July 9, 2001.	
Date <u>7/9/01</u>	<u>Debra Hom</u> Debra Hom

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